

THIS DISPOSITION IS NOT  
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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Medical and Life Insurance Company

Serial No. 75/493,928

Request For Reconsideration

Myron Amer of Myron Amer P.C. for American Medical and Life Insurance Company.

Howard Smiga, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hohein, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

American Medical and Life Insurance Company has requested reconsideration of the Board's September 4, 2002 decision affirming the Trademark Examining Attorney's refusal to register the mark SECURITY DENTAL PLAN on the Principal Register for "underwriting insurance for pre-paid dental care." We affirmed the refusal to register on the ground that applicant's mark, when applied to its services, so resembles the mark SECURITY HEALTH PLAN and design, registered for "underwriting insurance for pre-paid health

care," as to be likely to cause confusion, to cause mistake or to deceive.

Applicant maintains that the Board's decision failed explicitly to consider its arguments directed to the ninth du Pont factor:

The decision is stated to follow the guidance of the du Pont case which, if relevant information is of record, sets forth the below as one factor that should be considered in determining likelihood of confusion:

"(9) The variety of goods on which a mark is or is not used (house mark, ... product [services])."

Thus, in the parenthetical phrase the separate references to "house" mark and to "product [service]" mark makes the distinction between the two. If this distinction is recognized and applied, then the TTAB's conclusive assertion fails that "these third-party registrations [made of record by the trademark attorney] have probative value to the extent that they suggest that the services involved in this appeal are of a type that may emanate from a single source under the same mark (underlining added) [at decision, page 4 in lines 11-15] and with this failure, it then follows that the record lacks "rational reasons" to conclude that the word SECURITY would be more of a cognitive factor in how applicant's mark is perceived than the word DENTAL.

The three-word marks under consideration are NOT house marks and the record is totally devoid of "rational reasons" for concluding otherwise. If they were house marks, then the trademark attorney would have proved what he contends, but this is not the case. The three-word sequences are garden variety, non-house service marks, and a member of the public would, as TMEP

1201.01(1) mandates and likewise does also factor [10] of the du Pont case mandates, consider these sequences in their entirety, and if he/she is concerned with insurance for dental problems would contract for such focused insurance under the designation SECURITY DENTAL PLAN and not mistakenly under SECURITY HEALTH PLAN.

(Applicant's request for reconsideration, p. 2).

We have considered carefully the points raised anew by applicant. In our earlier opinion, the Board did not ignore the distinctions applicant's counsel posed in his briefs but, rather, properly discounted them without extensive comment. In any event, as indicated herein, we are of the view that our initial decision was correct.

According to applicant, we have not correctly analyzed the ninth factor of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973):

(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

This factor presumes that when the senior user / registrant uses its mark on a wide range of goods or services, the registration should be given a wider scope of protection than if used, for example, on a single item. Certainly this goes to how well-known a mark may be, how large should be its natural zone of expansion, and how likely it is that registrant's consumers will mistakenly

assume a common source when a junior party adopts and uses the same or similar mark on somewhat related goods or services.

However, consistent with counsel's argument, applicant has proceeded to divide each of the use-based, third-party registrations placed into the record by the Trademark Examining Attorney into the category of a "house mark" or "product/service mark." Applicant seems to argue that we are considering two product/service marks in the instant case, but that these third-party registrations have probative value only when we are dealing with a house mark.

Actually, these third-party registrations merely corroborate our conclusions that the services herein are related (du Pont factor 2) and that they often flow in the same likely-to-continue channels of trade (du Pont factor 3) to the same ordinary clients (du Pont factor 4).

Without any foundation or extrinsic evidence, applicant has simply concluded that certain service marks (e.g., those that match a registrant's trade name or consist of the acronym for its organization, etc.) are house marks deserving broad protection across different lines of insurance, while slogans and product/service marks should be given a narrow scope of protection.

We note that this ninth du Pont factor does not usually come into play in *ex parte* proceedings because in most cases, as here, the file contains no evidence as to how registrant is actually using its mark (e.g., as a house mark, a product mark, etc.). That is, no information relevant to the ninth du Pont factor had been made of record in this case. Hence, in reaching our earlier determination that confusion is likely herein, we deemed this factor to be neutral, favoring neither the position of applicant nor of the Trademark Examining Attorney.

Moreover, even if one accepts applicant's approach (which we do not), the fact remains that the Trademark Examining Attorney introduced for the record a number of third-party registrations involving slogans and product marks having been registered for both dental and medical insurance. Logically then, these registrations would support a finding of a likelihood of confusion herein even absent those registrations deemed by applicant to involve house marks.

In short, applicant seems to have created this entire argument out of whole cloth. Applicant cites to no precedent but nonetheless urges us casually to adopt this simplistic distinction before deciding that the ninth du Pont factor alone trumps all other considerations that

have been made of record during the course of this *ex parte* proceeding.

For the reasons discussed in our decision, as well as those reviewed above, we adhere to our finding that SECURITY DENTAL PLAN when used with "underwriting insurance for pre-paid dental care," is likely to cause confusion with SECURITY HEALTH PLAN and design registered for "underwriting insurance for pre-paid health care."

**Decision:** The request for reconsideration is denied.